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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/999,730	12/24/1997	ROBERT H. STAAT	7311-24RE	4290

570 7590 02/25/2004

AKIN GUMP STRAUSS HAUER & FELD L.L.P.
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2005 MARKET STREET, SUITE 2200
PHILADELPHIA, PA 19103-7013

EXAMINER

MORANO IV, SAMUEL J

ART UNIT	PAPER NUMBER
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3617

DATE MAILED: 02/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

08/999,730

Applicant(s)

STAAT, ROBERT H.

Examiner

S. Joseph Morano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☒ Other: *Copy of recapture guidelines.*

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1. In view of the Appeal Brief filed on August 6, 2003 and a shift in Office recapture policy based on precedent setting Board of Appeals decisions, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

2. The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

a. The only identified error in any of the declarations is no longer being corrected because of amendments made during the prosecution of the application, and

b. Because it fails to contain a statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant.

With regard to item a), above the only error listed in the declaration for which this reissue is based on is that applicant claimed more than they had a right to claim

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in the original patent. In particular, the limitation in original patent claim 1 of "a pair of limit stops on the coupler head for limiting the movement of a coupler knuckler" was not necessary in applicant's opinion. As a result applicant originally removed this limitation from the claims. Upon final allowance of reissue claims, the declaration must be reviewed to ensure that at least one error in the original patent is in fact being corrected. In response to various rejections during the prosecution of this application, applicant subsequently added back into all of the claims this limitation. Thus, the only "error" in the patent identified in the declaration is not in fact being corrected because all of the claims contain the limitation of the limit stops. It should be noted that removal of this limitation from the claims is not suggested, because it would result in a recurrence of the recapture rejection. This is because during the original prosecution history of the file, the addition of this limitation was expressly required by the examiner in order to make the claims patentable. Thus, even under the new relaxed recapture guidelines, removal of this limitation from any original claim (thereby reinstating the originally indicated error) would still be recapture and would result in a final rejection. Instead, since as noted in the attorney's remarks in the initial preliminary amendment that original claim 1 was also changed to recite additional limitations to the cantilever spring, it is suggested that the new declaration specifically refer to this error as the one being corrected by reissue. As currently pending claim 6 still calls for the "cantilever spring having a first portion which curves away from the coupler head and a free end which curves back toward the coupler knuckle to apply a tangential force to the coupler knuckle", it is suggested that adding this specific language to the declaration and stating that this is the error being corrected by reissue, should correct this problem.

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With regard to item b) above, any change in claim scope must be accompanied by a supplemental declaration that clearly indicates that the new changes were made without deceptive intent. Although the correction of the objected to items noted in paragraph 1 of the last Office action (mailed March 6, 2003) are merely changes of a minor typographical nature and would not require a new supplemental declaration, the changing of claim 35 to be re-written to include the limitations of claim 10 instead of claim 9 (in response to paragraph 3 of the last Office action) is a change in claim scope and therefore of substance. This change does require a new deceptive intent statement in a supplemental declaration, and a supplemental oath/declaration with the following suggested language should correct this problem: "Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant".

3. Claims 2-36 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.


4. The recapture rejection of claims 10, 12-16 and 18-20 has been withdrawn. Subsequent to the last Office action of March 6, 2003, the USPTO issued new guidelines to the examiners for recapture rejections in reissue applications. These new guidelines superceded previous ones that were being used, and were the result of precedent setting decisions on recapture from the Board of Appeals. The sole basis of

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the recapture rejection of claims 10, 12-16 and 18-20 on appeal was reflective of the old examiner guidelines. Upon review of appellant's brief in preparation for the Examiner's Answer, it was realized that under the new guidelines the recapture rejection was no longer appropriate. Given the tortuous and lengthy nature of the prosecution history of this case, a copy of these new guidelines has been included with this Office action for applicant's convenience. The new rejection based upon a defective oath/declaration is the sole rejection in this application, and was necessitated by applicant's amendment changing the scope of claim 35 and the final review of file prior to allowance to ensure that at least one error identified in the declaration was in fact being corrected. As discussed above, a new declaration correcting the defects a) and b) should allow this case to pass to issue.

5. Any inquiry concerning this communication should be directed to S. Joseph Morano at telephone number (703) 308-0230. Supervisory Patent Examiner Morano can normally be reached Monday through Thursday and every other Friday, generally between 6:00am-3:30pm EST.

Sjm
February 25, 2004



S. JOSEPH MORANO
SUPERVISORY PATENT EXAMINER
PHOTOGRAPHY CENTER 3600



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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MEMORANDUM

Date: August 4, 2003

To: Patent Examining Technology Center Directors
Patent Examining Corps

From: *Stephen G. Kunin*
Stephen G. Kunin
Deputy Commissioner for Patent Examination Policy

Subject: Updated Guidance as to Applying the Recapture Rule to Reissue Applications

This memorandum sets forth Office policy for addressing recapture issues in reissue applications, in view of recent case law. The substance of this memorandum will be incorporated into Chapter 1400 of the MPEP in the next revision.

Office policy for addressing reissue recapture issues is set forth in MPEP § 1412.02 - Recapture of Canceled Subject Matter. A recent decision of the Court of Appeals for the Federal Circuit and two recent decisions of the Board of Patent Appeals and Interferences have made it necessary for the Office to revise the existing recapture policy in the Office. These decisions are *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001), *Ex parte Yamaguchi*, 61 USPQ2d 1043 (Bd. Pat. App. & Inter. 2001)(reported but unpublished, precedential), and *Ex Parte Eggert*, Appeal No. 2001-0790 (Bd. Pat. App. & Inter. May 29, 2003)(a precedential opinion of an expanded panel of the Board). Attachment A provides examples where recapture is an issue, and Attachment B is a recapture-analysis flow chart.

The following guidance is provided to assist Office personnel in addressing reissue recapture issues. The guidance provided herein is effective immediately.

I. Summary:

1) The test for determining the presence of recapture or lack thereof is now to be stated in examiners' Office actions to be a three step process. (*Pannu*) The first step is to determine whether, and in what aspect(s), the reissue claims are broader than the patent claims. The second step is to determine whether the broader aspect(s) of the reissued claims relate to surrendered

subject matter. Finally, in the third step, it is to be determined whether the reissued claims were materially narrowed in other respects to avoid the recapture rule.

2) When analyzing a reissue claim for the possibility of impermissible recapture, there are two different types of analysis that must be performed. First, the reissue claim must be compared to any claims canceled or amended during prosecution of the original application. It is impermissible recapture for a reissue claim to be as broad or broader in scope than any claim that was canceled or amended in the original prosecution. Claim scope that was canceled or amended is deemed surrendered and therefore barred from reissue. Second, it must be determined whether the reissue claim entirely omits any limitation that was added/argued during the original prosecution to overcome an art rejection. Such an omission in a reissue claim, even if it includes other limitations making the reissue claim narrower than the patent claim in other aspects, is impermissible recapture. (*Pdñnu*) However, if the reissue claim recites a broader form of the key limitation added/argued during original prosecution to overcome an art rejection (and therefore not entirely removing that key limitation), then the reissue claim may not be rejected under the recapture doctrine. (*Eggert*) For example, if the key limitation added to overcome an art rejection was "an orange peel," and the reissue claim instead recites "a citrus fruit peel," the reissue claim may not be rejected on recapture grounds.

* { 3) The Board (in *Yamaguchi*) has also recently held that an examiner's reasons for allowance statement (as opposed to an examiner's amendment) which identifies a claim limitation as the basis for allowing the original application does not result in that limitation being surrendered, and cannot serve as a basis for recapture. Only an applicant's statement, argument, or amendment (which might be made via an examiner's amendment consented to by applicant) can establish a surrender of claimed subject matter on which to base recapture.

II. Recapture Baseline set by MPEP § 1412.02:

A reissue patent will not be granted to "recapture" claimed subject matter which was "surrendered" to obtain an original patent. As pointed out in MPEP § 1412.02, a patentee cannot recapture, in a reissue application, claims that are of (a) an equal scope, or (b) a broader scope, than the claim subject matter "canceled" from the original application in favor of more specific claims, in order to overcome an art rejection.¹ As further pointed out in MPEP § 1412.02, surrender can occur through arguments alone (without claim amendment in the application) - "surrendered subject matter" will be considered to have "crept into the reissue claim" where the patentee presents in the reissue application a *claim that excludes the claim limitation(s) which applicant had argued to*

¹ The "cancellation" of claim subject matter can be by deleting the claim and substituting a narrower claim, or by amending the existing claim so that it becomes narrower.

*distinguish over the art in obtaining the patent.*² These two principles are the base-line for recapture which is set forth in MPEP § 1412.02.

III. Additions to the baseline by *Pannu* and *Eggert*:

Pannu provides a clear statement that recapture is not always avoided by making a reissue claim narrower than the claim subject matter "canceled" from the original application in favor of more specific claim subject matter, in order to overcome an art rejection. The *Pannu* court decided that a limitation A which was added in an original application to overcome an art rejection cannot then be omitted in a reissue application and replaced by a different narrowing limitation, B, which is not related to limitation A. As stated in *Pannu*, 258 F.3d at 1372, 59 USPQ2d at 1601, "[o]n reissue, [the patent owner] is estopped from attempting to recapture the precise limitation he added to overcome prior art rejections." (Emphasis supplied.) Once a patent is obtained by adding a limitation to the claims to define over the art, that limitation, or a limitation related to that limitation³, must remain in the claims.

As a result of *Pannu*, the following can be stated:

A. Given:

- (1) A claim limitation is presented/argued/stated in an original application to make the claims allowable over an art rejection made in the original application, and
- (2) The claim limitation is then omitted, in its entirety, in the reissue application claims.

Then:

The omitted limitation relates to subject matter previously surrendered by applicant, impermissible recapture of the surrendered subject matter exists, and the reissue application

² "[W]e conclude that, in a proper case, a surrender can occur through arguments alone. We next evaluate whether such a surrender occurred here with respect to the 'solely with steam' and 'two sources of steam' limitations, the pertinent aspects in which the asserted reissue claims are broader than the original patent claims. The obvious conclusion is that there has been a surrender.

As detailed above, Williams repeatedly argued that the 'solely with steam' and 'two sources of steam' limitations distinguished the original claims from the prior art. ...

None of the asserted reissue claims include either the 'solely with steam' limitation or the 'two sources of steam' limitation. Thus, this surrendered subject matter--i.e., cooking other than solely with steam and with at least two sources of steam--has crept into the reissue claims." [*Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d at 1482, 46 USPQ2d at 1649 (Fed. Cir. 1998)]

³ See *Eggert*.

claims should be rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the reissue application is based.⁴

- B.** If the omitted limitation is replaced by another limitation that is not related to the subject matter previously surrendered by applicant, recapture exists, even though the replacement limitation is a material (narrowing) limitation, and even where the replacement limitation defines the claim(s) over the prior art. *See Clement* principle 3(a).⁵
- C.** If the omitted limitation is replaced by another limitation that is related to the subject matter previously surrendered by applicant, recapture has been avoided. The replacement limitation certainly can be more specific than the omitted limitation. In addition, the *Eggert* decision held that the related replacement limitation can be broader than the omitted limitation, as long as the replacement limitation provides a claim that is narrower than the "canceled" claim subject matter, i.e., narrower than the subject matter "canceled" from the original application (in favor of more specific claim subject matter) in order to overcome an art rejection. The holding in *Eggert* is to be strictly limited to the facts of the case.

These three principles will be illustrated as follows:

Principle A. Given (1) a claim limitation is presented/argued/stated in an original application to make the claims allowable over an art rejection made in the original application, and (2) the claim limitation is then omitted, in its entirety, in the reissue application claims, then the omitted limitation relates to subject matter previously surrendered by applicant, and impermissible recapture of that surrendered subject matter exists.

This situation is where the original patent claims are directed to the combination ABC, and the reissue claims are directed to the combination AB. Element C was added (in the prosecution of the original application) to the claimed combination of AB to obtain allowance of the original patent, and/or the presence of element C in the claimed combination was argued by applicant to define over the art. Thus, the addition of element C and/or argument as to element C results in the surrender of any claim combination of A and B that does not include C. The combination of

⁴ Thus, if a claim limitation is newly presented, argued or stated in an application to make the claims patentable over an art rejection made in that application, and the application is then allowed, then applicant has surrendered to the public any future claiming of the invention that does not contain that limitation.

⁵ "(3) if the reissue claim is broader in some aspects, but narrower in others, then: (a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim;" [*Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165]

A and B without C is the surrendered subject matter.⁶ The reissue claim, which no longer contains element C, is broadened in an area related to the surrender (claim subject matter not having C), and the claim combination of AB in the reissue is barred as recapture.

The situation where element C was added by amendment (in the prosecution of the original application) to the claimed combination of AB to obtain allowance of the original patent (and C is then not included in the reissue claim) is the classic case of recapture. See for example *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 27 USPQ2d 1521 (Fed. Cir. 1993); or *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984);

The situation where element C was present in the originally claimed combination ABC (i.e., it was not added by amendment), but element C was argued by applicant to define over the art to obtain allowance of the original patent (and C is not included in the reissue claim) has been more recently clarified by the Federal Circuit to be recapture - see *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998).

Principle B. If a limitation added/argued to overcome an art rejection during the original prosecution is replaced in the reissue claims by another limitation that is not related to the added/argued limitation, then recapture exists, even where the replacement limitation defines the claim(s) over the prior art.

Assume that the patent claims are directed to the combination ABC (for a method of baking a pie), and the reissue application claims are then directed to the combination ABD. Further assume element C is an oven, while element D is a pre-mixing apparatus. In this instance, element C was added (in the prosecution of the original application) to the claimed combination of AB in order to define over the art rejection and thereby obtain allowance of the original patent. Thus, the addition of element C has resulted in the surrender of any claim combination of A & B that does not also include element C. Element D of the ABD combination claimed in the reissue application is not related to the surrendered subject matter. Thus, the reissue claim to ABD, which no longer contains element C, is broadened in an aspect germane to the art rejection, and the narrowing (of the "canceled" claim subject matter to AB) via the addition of D does not save the claim from recapture since D is not related to the surrendered subject matter. See *Pannu*.

Principle C. If a limitation added/argued to overcome an art rejection during the original prosecution is replaced by another limitation that is related to the added/argued limitation, then there is no recapture. The replacement limitation certainly can be more specific than the omitted limitation. In addition, *Eggert* held that the related replacement limitation can be broader than the omitted limitation, as long as it is not as it does not result in the reissue claim being as broad as the canceled claim (or broader).

⁶ The subject matter of A alone (i.e., without B and C) and B alone (i.e., without A and C) has also been surrendered, but such is not relevant for this discussion.

Assume that a claimed combination AB was originally presented in an original application, and the claims were then amended in response to an art rejection to add element C and thus provide ABC (after which the patent issued). A reissue application is then filed, and the reissue application claims are directed to combination ABC_{broadened}. Element C might be a broiler, while element C_{broadened} is a cooking means. The Element C broiler is "omitted" from the reissue claims; the element C_{broadened} cooking means replaces the broiler, and is thus the "replacement" limitation. A cooking means is broader than a broiler, since there are other cooking means such as a fryer, a boiler, a steamer, or the like. It is to be observed that the ABC_{broadened} claims (having the cooking means) are narrowed in scope when compared with the "canceled" claim subject matter AB (not having the cooking means), since C_{broadened} is required in addition to AB. Further, the cooking means limitation C_{broadened} is related to the surrender, since it was element C (a broiler, which is a type of cooking means) that was added in the original application to overcome the art. There is no recapture in this instance, since the ABC_{broadened} claim is narrower than "canceled" claim subject matter AB, and the ABC_{broadened} claim does not entirely omit the C limitation previously added to overcome the art. *See Eggert.*

IV. Further Discussion of Recapture as a result of *Pannu* and *Eggert*:

In the prosecution of an application, a claim limitation (for example an element C, to be referred to as the "surrender limitation") is often added and/or argued by applicant to make the claims (for example, the combination of ABC) allowable over an art rejection; the claims are then allowed and a patent issues. In a later application requesting reissue of that patent, applicant cannot then omit or eliminate that limitation (applicant cannot omit C to thereby claim the combination of AB). Claim subject matter which omits that limitation (element C) has been surrendered in the prosecution of the original application, and applicant cannot then recapture that claim subject matter by way of reissue.⁷

The reissue application can, however, provide a "replacement limitation" for the "surrender limitation," if the replacement limitation is "related" to the surrender limitation (i.e., element C is replaced by C').⁸ Case law of the Federal Circuit culminating in *Pannu* has defined the required relationship (between C and C') to require that the replacement limitation (C') must narrow the claims in the same way that the surrender limitation (C) narrowed the claims. It is insufficient that the claims be narrowed in a different area (not sufficient to provide the combination of ABX, where X is not related to C), even though the replacement limitation (X) added in the reissue application claims defines the claims (ABX) over the art.

⁷ See *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997) for a discussion of the importance of the recapture doctrine, and the analysis to be made in resolving recapture issues.

⁸ See *In re Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165; *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 994, 27 USPQ2d 1521, 1525 (Fed. Cir. 1993).

The *Eggert* decision held that the replacement limitation can be broader than the surrender limitation (C), as long as the replacement limitation narrows the claim that was amended to obtain allowance of the original patent claims (hereinafter "the canceled claim") and the narrowing is in the area of the surrender limitation. Thus, ABC can be broadened in a reissue application to provide ABC^{broadened}. If A is a cooler, B is a chopper, and C is a broiler, then C can be broadened in the reissue to be a cooker (C^{broadened}) and recapture is not present. By retreating from "broiler" to the broader "cooker," the claims can be made to encompass a steamer, a fryer, a baking oven, and like additional embodiments. This is the full extent of the *Eggert* holding.

The following *dicta*⁹ is set forth in *Eggert*, and is not to be followed by the Office:

1) The *Eggert* opinion states that the replacement limitation need not narrow the canceled claim in the area of the surrender limitation; the replacement limitation need only defines the claims over the art (that caused the original narrowing of the claims). Under this statement of *dicta*, original patent claims to ABC (where C is the surrender limitation) could be replaced in the reissue by claims to ABX, (where X is not related to C), and recapture would be avoided. **THIS DICTA IS NOT TO BE FOLLOWED**, because it is inconsistent with the Federal Circuit's decision in *Pannu*.

2) The *Eggert* opinion discussed two claim comparison models to utilize in determining the claim subject matter that was surrendered. The opinion states that the only viable option for claim comparison is:

I. The (broadened) reissue claim may be compared to the corresponding claim in the application that was amended or "canceled" to overcome the art (i.e., compared to the AB claim of the original application that was present before element C was added). If the reissue claim is broader than, or is as broad as, the "canceled claim" (e.g., by reciting AB, A, or AB^{broadened}), then there is recapture.

The *Eggert* opinion, however, rejects the following option:

II. The (broadened) reissue claim may be compared to the corresponding claim added to define over the art and issued as "the patent claim." If a **limitation** of the patent claim which was added to define over the art (i.e., limitation C of ABC), is no longer present in the reissue presentation of the claim (e.g., if the reissue claim is AB, ABX, or ABY), then recapture will be found, unless such **limitation** is replaced by a related limitation (e.g., the reissue claim is ABC^{broadened} or ABC^{narrowed}).

⁹ *Dicta* refers to statement(s) made by a member of the panel in the opinion rendered for the panel (of a court, administrative Board, etc.) which statement(s) are not necessary to the holding. The members of the panel can concur with the holding without concurring with the *dicta*, and the *dicta* is not binding precedent.

The rejection of option II set forth in the *Eggert* opinion IS *DICTA*, AND IS NOT TO BE FOLLOWED. Rather, both options I and II are viable for finding recapture. If the reissue claims fail the recapture test under either option, recapture is present.

V. Addition by *Yamaguchi*:

The *Yamaguchi* decision provides that a surrender of claimed subject matter cannot be based solely upon an applicant's failure to respond to, or failure to challenge, an examiner's statement made during the prosecution of an application. Applicant is bound only by *applicant's* revision of the application claims¹⁰ or a positive argument/statement by *applicant*. Applying this principle, an applicant's failure to present on the record a counter statement or comment as to an examiner's reasons for allowance does not give rise to any implication that applicant agreed with or acquiesced in the examiner's reasoning for allowance. Thus, the failure to present a counter statement or comment as to the examiner's reasons for allowance does not give rise to a finding of surrender. The examiner's statement of reasons for allowance in the original application *cannot, by itself, provide the basis for establishing surrender and recapture.*

It is only in the situation where applicant does file comments on the reasons for allowance, that surrender may have occurred. Note the following two scenarios in which an applicant files comments:

Scenario 1 - There is Surrender: The examiner's reasons for allowance in the original application stated that it was limitation C (of the combination of ABC) which distinguished over a potential combining of references X and Y, in that limitation C provided increased speed to the process. Applicant files comments on the reasons for allowance essentially supporting the examiner's reasons. The limitation C is thus established as relating to subject matter previously surrendered.

Scenario 2 - There is No Surrender: On the other hand, if applicant's comments on the reasons for allowance contain a counter statement that it is limitation B (of the combination of ABC), rather than C, which distinguishes the claims over the art, then limitation B was surrendered, and limitation C has not been surrendered.

VI. Three step recapture analysis

The *Pannu* court stated the *Clement* test for determining the presence of recapture or lack thereof

¹⁰ Such revision would include addition, cancellation, or amendment of claims, or even an amendment of the specification/drawings in a manner that changes the scope of the claims. Such revision would include an examiner's amendment consented to by applicant, even though it is the examiner who actively drafts the amendment.

as a three step analysis:.

Application of the recapture rule is a three-step process. The first step is to "determine whether and in what 'aspect' the reissue claims are broader than the patent claims." ... "The second step is to determine whether the broader aspects of the reissued claim related to surrendered subject matter." ... Finally, the court must determine whether the reissued claims were materially narrowed in other respects to avoid the recapture rule. [*Pannu*, 258 F.3d at 1371, 59 USPQ2d at 1600]

In the MPEP discussion of recapture which was drafted prior to *Pannu*, the *Clement* third prong has been viewed as a refinement of the second step, and thus only two steps were set forth in MPEP § 1412.02. The Federal Circuit has now made a clear statement (in the *Pannu* opinion) that the recapture analysis is viewed as a three step process; thus, any recapture analysis made by an examiner is to be stated in terms of all three steps. See Attachment A for guidance in applying the third step (i.e, the third prong) of the recapture analysis.

VII. Flow chart:

Attachment B is a flow chart provided to assist personnel in determining whether recapture is present, consistent with the case law discussed above.

VIII. Contact Persons:

For questions as to the materials provided above, please contact Ken Schor, a Senior Legal Advisor in the Office of Patent Legal Administration, at 308-6710 or by e-mail (Schor, Kenneth).

For questions as to recapture in general, the Special Program Examiners (SPREs) of the Technology Centers should be consulted by the examiners, and any problem which cannot resolved at the SPRE level forwarded to Ken Schor (308-6710) or Joe Narcavage (305-1795) of the Office of Patent Legal Administration.

Attachments: A - Surrender for Reissue Recapture - The Second & Third Prongs of the Recapture Analysis - *A Breakdown by Scope of Reissue Claims*
B - Recapture Flow Chart

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Edward R. Kazenske
Esther M. Kepplinger

Attachment A

Surrender for Reissue Recapture - The Second & Third Prongs of the Recapture Analysis *A Breakdown by Scope of Reissue Claims*

In *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 1371, 59 USPQ2d 1597, 1600 (Fed. Cir. 2001), the court stated:

Application of the recapture rule is a three-step process. The first step is to "determine whether and in what 'aspect' the reissue claims are broader than the patent claims." ... "The second step is to determine whether the broader aspects of the reissued claim related to surrendered subject matter." ... Finally, the court must determine whether the reissued claims were materially narrowed in other respects to avoid the recapture rule.

If the reissue claims are broader than the patent claims by removal of a limitation that was added in the patent prosecution to secure allowance over the art, and no replacement limitation has been added to narrow the patent claims, then the analysis ends. Recapture is present. Where a replacement limitation has been added to narrow the patent claims, the third step, i.e., third prong, of the recapture determination comes into play.

The third prong of the recapture determination, is directed to analysis of the broadening and narrowing effected via the reissue claims and of the significance of the claim limitations added and deleted, making use of the prosecution history of the patent (to be reissued), to determine whether the reissue claims should be barred as recapture. This attachment addresses analyzing the reissue claims, as well as the existing questions/confusion as to *which patent claims* are to be compared to the reissue claims in determining the issue of surrender (for reissue recapture). The attachment discusses the reissue claims (1) as compared with claims "canceled" from the original application¹ to obtain the patent for which reissue is now being sought, and (2) as compared with the patent claims of the original patent. The discussion incorporates the recent holdings of *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001), *Ex parte Yamaguchi*, 61 USPQ2d 1043 (Bd. Pat. App. & Inter. 2001)(reported but unpublished, precedential), and *Ex Parte Eggert*, Appeal No. 2001-0790 (Bd. Pat. App. & Inter. May 29, 2003)(precedential).

In analyzing reissue claims for recapture, the examiner must conduct two separate types of analysis, which are set out below.

¹ I.e., canceled claim subject matter.

I. Comparison of Reissue Claims narrowed/broadened *vis a-vis* the Canceled Claims

DEFINITION: "Canceled claims," in the context of recapture case law, are claims canceled from the original application to obtain the patent for which reissue is now being sought. The claims

- (1) can simply be canceled and not replaced by others, or
- (2) can be canceled and replaced² by other claims which are more specific than the canceled claims in at least one aspect (to thereby define over the art of record).

A. Reissue claims are same or broader in scope than canceled claims in all aspects:

The recapture rule bars the patentee from acquiring, through reissue, claims that are in all aspects (a) of the same scope as, or (b) broader in scope than, those claims canceled from the original application to obtain a patent. *In re Ball*, 729 F.2d at 1436, 221 USPQ at 295.

B. Reissue claims are narrower in scope than canceled claims in at least one aspect:

[A preliminary note: If the reissue claims are equal in scope to, or narrower than, the claims of the original patent (as opposed to the claims "canceled from the application") in all aspects, then there can never be recapture. The discussion that follows is not directed to that situation. It is rather directed to the situation where the *reissue claims are narrower than the claims "canceled" from the application in some aspect, but are broader than the claims of the original patent in some aspect.*]

If the reissue claims are narrower in scope than the claims canceled from the original application by inclusion of *the limitation added to define the original application claims over the art*, there will be no recapture, even if the reissue claims are broader than the canceled claims in some other aspect (i.e., an aspect not related to the surrender made in the original application).

Assume combination AB was originally presented in the application, and was amended in response to an art rejection to add element C and thus provide ABC (after which the patent issued). The reissue claims are then directed to combination AB_{broadened}C. The AB_{broadened}C claims are *narrower* in scope when compared with the canceled claim subject matter AB *in respect to the addition of C* (which was added in the application to overcome the art), and there is no recapture.

As another example, assume combination ABZ was originally presented in the application, and was amended in response to an art rejection to add element C and thus provide ABZC (after which the patent issued). The reissue claims are then directed to combination ABC (i.e., element

² The "replacement claims" can be new claims which are narrower than the canceled claims, or can be the same claims amended to be narrower than the canceled version of the claims.

Z is deleted from the canceled claims, while element C remains present). The ABC claims of the reissue are *narrower* in scope as compared to the canceled-from-the-original-application claim subject matter ABZ *in respect to the addition of C* (which was added in the application to overcome the art), and there is thus no recapture.

II. Comparison of Reissue Claims narrowed/broadened *vis a-vis* the Patent Claims

The "patent claims," in the context of recapture case law, are claims which issued in the original patent for which reissue is now being sought. As pointed out above, where the reissue claims are narrower than³ the claims of the original patent in all aspects, then there can never be recapture. Where, however, reissue claims are both broadened and narrowed as compared with the original patent claims, the nature of the broadening and narrowing must be examined to determine whether the reissue claims are barred as being recapture of surrendered subject matter. If the claims are "broader than they are narrower in a manner directly pertinent to the subject matter ... surrendered during prosecution" (*Clement*, 131 F.3d at 1471, 45 USPQ2d at 1166), then recapture will bar the claims. This narrowing/broadening vis-a-vis the patent is broken down into four possibilities that will now be addressed.

Working definition for purposes of this section - *surrender-generating limitation*:

The "limitation" presented, argued or stated to make the claims patentable over the art (in the application) "generates" the surrender of claimed subject matter that omits that limitation in its entirety, i.e., surrender of any claim whose scope does not contain the limitation. For the sake of simplification, this limitation will be referred to throughout this section as the *surrender-generating limitation*. If a claim is presented in a reissue application that omits, in its entirety, the surrender-generating limitation, that claim impermissibly recaptures what was previously surrendered, and that claim is barred under 35 U.S.C. 251. This terminology will be used in the discussion of the four categories of narrowing/broadening vis-a-vis the patent that follows.

- A. **Reissue claims are narrower in scope than patent claims, in area not directed to amendment/argument made to overcome art rejection in original prosecution; are broader in scope by omitting limitation(s) added/argued to overcome art rejection in original prosecution:**

In this case, there is recapture.

This situation is where the patent claims are directed to combination ABC and the reissue claims are directed to ABD. Element C was either a limitation added to AB to obtain allowance of the original patent, or was argued by applicant to define over the art (or both). Thus, addition of C (and/or argument as to C) has resulted in the surrender of any combination of A & B that does not include C; this is the surrendered subject matter. Element D, on the other hand, is not related

³ If reissue claims are equal in scope to the patent claims, there is no recapture as to those reissue claims; but that is self evident, and as such, is not addressed.

to the surrendered subject matter. Thus, the reissue claim, which no longer contains C, is broadened in an area related to the surrender, and the narrowing via the addition of D does not save the claim from recapture since D is not related to the surrendered subject matter.

Reissue claims that are broader than the original patent claims by not including the surrender-generating limitation (element C, in the example given) will be barred by the recapture rule even though there is narrowing of the claims not related to the surrender-generating limitation. As stated in the decision of *In re Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165, if the reissue claim is broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim. *Pannu v. Storz Instruments Inc.*, *supra*, then brings home the point by providing an actual fact situation in which this scenario was held to be recapture.

- B. Reissue claims are narrower or equal in scope, in area directed to amendment/argument made to overcome art rejection in original prosecution; are broader in scope in area not directed to amendment/argument:**

In this case, there is no recapture.

This situation is where the patent claims are directed to combination ABCDE and the reissue claims are directed to ABDE (element C is omitted). Assume that the combination of ABCD was present in the original application as it was filed, and element E was later added to define over that art. No argument was ever presented as to elements A-C defining over the art.

In this situation, the ABCDE combination of the patent can be broadened (in the reissue application) to omit element C, and thereby claim the combination of ABDE, where element E (the surrender generating limitation) is not omitted. There would be no recapture in this instance.⁴

Additionally, the reissue claims are certainly permitted to recite combination ABDE_{specific} (where surrender-generating element E is narrowed). The patent claims have been broadened in an area not directed to the surrender (by omitting element C) and narrowed in the area of surrender (by narrowing element E to E_{specific}). This is clearly permitted.

As another example, assume limitation C was added to application claims AB to obtain the patent to ABC, and now the reissue presents claims to AC or AB_{broad}C. Such reissue claims avoid the effect of the recapture rule because they are broader in a way that does not attempt to reclaim what was surrendered earlier. *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 994, 27 USPQ2d 1521, 1525 (Fed. Cir. 1993). Such claims are considered to be broader in an aspect not "germane to a prior art rejection," and thus are not barred by recapture. Note *In re Clement*, 131

⁴ If argument had been presented as to element C defining over the art, in addition to the addition of element E, then the ABCDE combination could not be broadened to omit element C and thereby claim combination of ABDE. This would be recapture; see the above discussion as to surrender and recapture based upon argument.

F.3d at 1470, 45 USPQ2d at 1165.

Reissue claims that are broader than the original patent claims by deletion of a limitation or claim requirement other than the "surrender-generating limitation" will avoid the effect of the recapture rule, regardless of the nature of the narrowing in the claims, and even if the claims are not narrowed at all from the scope of the patent claims.

- C. Reissue claims are narrower in scope in area not directed to amendment/argument made to overcome art rejection in original prosecution; are broader in scope in area not directed to the amendment/argument:**

In this instance, there is clearly no recapture. In the reissue application, there has been no change in the claims related to the matter surrendered in the original application for the patent.

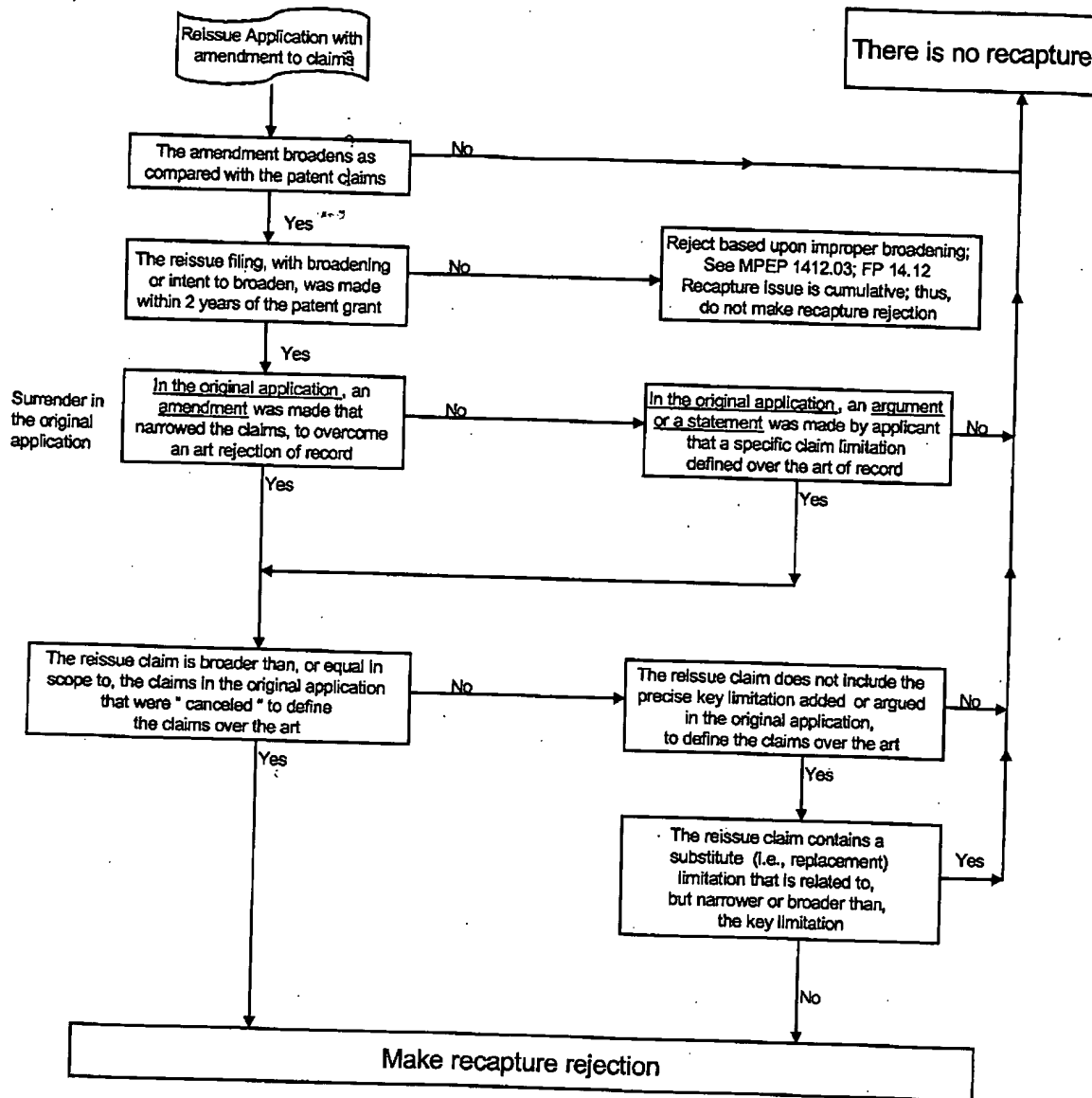
In this instance, element C was added to the AB combination to provide ABC and define over the art, and the patent was issued. The reissue omits element B and adds element Z, to thus claim ACZ. There is no recapture since the surrender generating element C has not been modified in any way.⁵

- D. Reissue claims broader in scope in area directed to amendment/argument made to overcome art rejection in original prosecution; but reissue claims retain, in broadened form, the limitation(s) argued/added to overcome art rejection in original prosecution:**

Assume the combination AB was originally claimed in the application, and was amended in response to an art rejection to add element C and thus provide the combination ABC (after which the patent issued). A reissue application is then filed, and the reissue application claims are directed to the combination ABC^{broadened}. The ABC^{broadened} claims are narrowed in scope when compared with the canceled claim subject matter AB, because of the addition of C^{broadened}. Thus, the claims retain, in broadened form, the limitation argued/added to overcome art rejection in original prosecution. There is no recapture, since ABC^{broadened} is narrower than canceled claim subject matter AB in an area related to the surrender. This is so, because it was element C that was added in the application to overcome the art. See *Ex Parte Eggert*, Appeal No. 2001-0790 (Bd. Pat. App. & Inter. May 29, 2003)(precedential).

⁵ Note, however, that if, when element C was added to AB, applicant argued that the association of newly added C with B provides a synergistic (unexpected) result to thus define over the art, then neither B nor C could be omitted in the reissue application.

Reissue Recapture - Determining its presence or absence



Ken Schor 7/10/03

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